

REMARKS

Applicants respectfully request reconsideration in view of the amendment and following remarks. Support for newly added claim 29 can be found in claim 13. No additional fee is required for the amendment.

Applicants affirm their election of the phosphate species without traverse. Claims 13 through 28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Papai U.S. Patent No. 6, 221,570 (hereinafter referred to as "Papai '570") provisionally with Papai's allowed application Serial No. 09/715,612 which is the equivalent of WO 01/50196 (hereinafter referred to as "Papai '196") considered with Meckel *et al.* U.S. Patent No. 3,293,036 (hereinafter referred to as "Meckel"), Ohkubo *et al.* U.S. Patent No. 3,591,380 (hereinafter referred to as "Ohkubo"), Williams *et al.* U.S. Patent No. 3,702,247 (hereinafter referred to as "Williams") and Schranz *et al.* U.S. Patent No. 3,879,203 (hereinafter referred to as "Schranz"). The applicants respectfully traverse this rejection.

The priority text filed Jan. 6, 2000 in Papai '570 gives no hint to use phosphoric acid derivatives to stabilize a bleach-fixing concentrate. These compounds are only listed among many others as possible metal complexants on column 5, lines 21 to 46 and as acid for pH adjustment on column 8, lines 34-37 of Papai '570. Again, there is no suggestion to selectively choose the applicants' claimed ingredients.

As taught by Papai '570, the thiocyanate salt is essential to achieve stable concentrates (see *e.g.* column 7, lines 39 to 46, column 6, lines 37 to 55 and the whole disclosure), and has to be used, although thiocyanate has severe disadvantages and even may produce toxic cyanide gas as taught on column 6, lines 28-36.

If Papai had known the preferred and in every aspect advantageous way to stabilize bleach fixing concentrates as taught by our invention and taught in WO 01/50196, he would have disclosed it on Jan. 6th, 2000 and not on Nov. 17th, 2000. Further evidence that Papai did not recognize the applicants' claimed combination is in WO 01/50191 which also claims priority to the January 6, 2002 earlier application (Serial Number US 09/477,565). The disclosure appears to be the same as Papai '570.

None of the teaching in Papai '196 concerning the stabilizing effect of phosphate *e.g.* page 7, lines 21 to page 8, lines 22, page 16 I. 9 to page 17, lines 2 and Examples 5, 6 has been disclosed in Papai '570 or WO 01/50191. Papai '196 claims benefit to both US 09/477,565 filed January 6, 2000 and US Serial Number 09/715,612 filed November 17, 2000. It is clear that this subject matter was added at the earliest, in the November 17, 2000 application.

Moreover on column 8, line 35 of Papai '570 and page 14, lines 24-25 of WO 01/50191 Papai states, "preferred acids have a carboxyl group, and most preferred is acetic acid", whereas on page 7, lines 21 to 22 of Papai '196 states, "one of the preferred acids is phosphoric acid".

Following these arguments it is applicants opinion, that applicants' invention was not known before May 27, 2000, which is our first filing date. Even the further filings of applicants' invention as of August 03, 2000 and August 14, 2000 are prior to the November 17, 2000 date. The applicants are in the process of procuring English certified translation of their priority documents and will submit the translation when they receive them. Then, the applicants believe that they are entitled to the effective filing date of their priority applications which would antedate Papai '196.

Meckl, Ohkubo, Williams and Schranz all show ready-to-use bleach-fixing solutions but no concentrates.

It may be trivial, to dilute concentrates with water, to get the ready to use solution, but surely the reversed way is not trivial.

There is no hint in said disclosures, how to combine the chemicals needed for a ready-to-use bleach fixing solution in a concentrate. Before the applicants' invention, all experiments have failed to achieve a one part bleach fixing concentrate that would result in a common ready-to-use solution on dilution, because at high concentrations the chemicals normally used (reducing and oxidizing ones) react with each other and some ingredients tend to crystallize.

Surprisingly, the applicants have found, that for a concentrate as claimed, the mere addition of phosphoric acid derivatives prevents this prohibitive degradation and crystallization without any disadvantages (*e.g.* the need of problematic thiocyanate).

There is no teaching in said disclosures related to ready-to-use solutions, that phosphate would allow to produce stable concentrates.

The same argument holds for Papai '570, who teaches that the problematic thiocyanate is essential for a stable one-part concentrate (column 7, lines 39 to 41).

The concentrate of applicants' invention is the first one-part bleach fixing concentrate that makes use of phosphoric acid derivatives as stabilizer without showing any disadvantages and therefore the rejection of the claims should be withdrawn.

The Examiner must consider the references as a whole, In re Yates, 211 USPQ 1149 (CCPA 1981). The Examiner cannot selectively pick and choose from the disclosed multitude of parameters without any direction as to the particular one selection of the

reference without proper motivation. The mere fact that the prior art may be modified to reflect features of the claimed invention does not make modification, and hence claimed invention, obvious unless desirability of such modification is suggested by the prior art (In re Baird, 29 USPQ 2d 1550 (CAFC 1994) and In re Fritch, 23 USPQ 2nd. 1780 (Fed. Cir. 1992)). The applicants disagree with the Examiner why one skilled in the art with the knowledge of the references would selectively modify the references in order to arrive at the applicants' claimed invention. The Examiner's argument is clearly based on hindsight reconstruction.

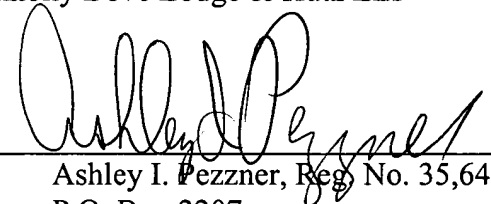
Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching, suggestion, or incentive supporting this combination, although it may have been obvious to try various combinations of teachings of the prior art references to achieve the applicants' claimed invention, such evidence does not establish *prima facie* case of obviousness (In re Geiger, 2 USPQ 2d. 1276 (Fed. Cir. 1987)). There would be no reason for one skilled in the art to combine Papai '570, Papai '196, Meckl, Ohkubo, Williams and Schranz. For the above reasons, this rejection should be withdrawn.

No additional fees are due. If there are any additional fees due in connection with the filing of this response, including any fees required for an additional extension of time under 37 CFR 1.136, such an extension is requested and the Commissioner is authorized to charge or credit any overpayment to Deposit Account No. 03-2775.

For the reasons set forth above, Applicants believe that the claims are patentable over the references cited and applied by the Examiner and a prompt and favorable action is solicited. The applicants believe that these claims are in condition for allowance, however, if the Examiner disagrees, the applicants respectfully request that the Examiner telephone the undersigned at (302) 888-6270.

Respectfully submitted,

Connolly Bove Lodge & Hutz LLP

By 
 Ashley I. Pezzner, Reg. No. 35,646
 P.O. Box 2207
 Wilmington, DE 19899
 (302) 658-9141

221771_1.DOC